

REMARKS

In an Office Action mailed February 25, 2004, the Examiner withdrew claims 20-27 from consideration in this application pursuant to Applicants' oral election. Applicants confirm the election of Group I claims 1-19, and now have cancelled without prejudice claims 20-27. No change in inventorship is necessitated by this amendment. Applicants also have amended the Abstract at the Examiner's request, and further have amended the title to reflect the above election of the Group I claims.

The Examiner rejected claims 1-7, 10-13 and 16-19 as being anticipated by, or made obvious over, U.S. Patent No. 3,716,132 to Lewyckyj. Applicants gratefully acknowledge the Examiner's statement that claims 8, 9, 14 and 15 would be allowed if rewritten in independent form.

In response, Applicants have amended claims 8 and 14 by rewriting them in independent form, but with a cancellation of the recitation of a "nip." Applicants have made the same broadening amendment to claims 5 (rewritten in independent form) and 11. Applicants also have amended claim 1 and added new claims 28-30. Applicants respectfully submit that all of the pending claims are patentable over Lewyckyj for at least the following reasons.

Claims 1, 2-4 and 10:

The Examiner rejected claim 1 as being anticipated by Lewyckyj. As now recited in claim 1, "weakening said line of weakness at said second location comprises *lengthening* at least a portion of said web *along said line of weakness* at said second location." As shown in FIG. 13 of the present application, "at least a portion of the web 100 is forced by the insert portions 130, 140 into the recesses 132 formed in the second roll so as to separate portions of the web along the line of weakness or to enlarge or unite the various perforation openings formed by the first weakening apparatus" (Specification at p. 14). In essence, by forcing a portion of the web into the recess, the web is stretched or lengthened at that location.

In contrast, Lewyckyj achieves a weakening of the web by crushing the web,

not by a lengthening thereof (see, e.g., Col. 2, lines 38-48). Indeed, nowhere in Lewyckyj is it disclosed or suggested that the web is stretched or lengthened, but rather only that it is crushed. In this respect, one of skill in the art would understand that while the blade 76 in Lewyckyj intermittently raises the web off of the roll 80, no portions of the web *itself* are lengthened by such interaction, but rather the web merely follows a slightly different or longer *path* when being carried by the blade. Instead, as shown in the embodiment of FIG. 6, the blade is merely raised above the roll so that it can interact with the anvils 74, 76 (Col. 7, lines 5-42). In the embodiment of FIG. 1 of Lewyckyj, the web does not even follow a different path as it is crushed.

For at least these reasons, Claim 1, and claims 2-4 and 10 which depend therefrom, should be passed to allowance.

Claims 5, 6, 7, 11, 12, 13, 16-19 and 28-30:

The Examiner rejected claims 5 and 11 as being made obvious over Lewyckyj. Claim 5, which has been rewritten in independent form, recites that “weakening said line of weakness at said second location comprises moving said web between a first *moveable* member and a second member, wherein said first *moveable* member comprises at least one insert member and wherein said second member comprises at least one recess shaped to receive said insert member, and further comprising *pushing at least a portion of said web at said line of weakness with said insert member into said recess.*”

Independent claim 11 recites “moving said web between *first and second moveable members* at said second location, wherein said first *moveable* member comprises at least one insert member and wherein said second *moveable* member comprises at least one recess shaped to receive said insert member; and *pushing at least a portion of said web at said cross-direction perforation with said insert member into said recess.*”

In contrast, Lewyckyj does not disclose or suggest a first *moveable* member

having an insert (Claim 5) received in a recess of another member, or first and second *moveable* members (Claim 11), wherein one of the members has an insert received in a recess of the other member. In this respect, it is important to note that the support/crushing rolls 44, 48 of FIG. 2 of Lewyckyj are completely devoid of any recess. Indeed, recognizing this deficiency, the Examiner relies on the embodiment of FIG. 6, with its blade 76 and anvils 72, 74, for the recited recess and insert member.

Revealingly, however, the Examiner referred to the carrier roll 80 as being a “second moveable member,” but referred to the anvil holder 70 merely as a “first member” (Office Action at 5) -- without the “moveable” recitation of claims 5 and 11. As such, the Examiner correctly recognized the shortcomings of Lewyckyj – it does not disclose or suggest a moveable member having an insert received in a recess of another member. The absence, however, of a first moveable member having an insert received in a recess of a second member, or first and second *moveable* members, having an insert and recess respectively, precludes a prima facie case of obviousness.

Moreover, there is absolutely no suggestion in Lewyckyj to make the anvil 56, 70, 72, 74 moveable, contrary to any assertions made by the Examiner. Indeed, just the opposite is true – the “anvil 56, . . . is firmly mounted in a *stationary* anvil holder 58” (Col. 5, lines 46-48) (emphasis added), and “a *fixed* anvil holder 70 is provided for mounting a notched anvil 72 and an unnotched anvil 74” (Col. 7, lines 7-10) (emphasis added). Accordingly, Lewyckyj actually teaches against the claimed combination and claims 5 and 11 should be passed to allowance on this basis alone.

In addition, and even if “fixed” members are somehow made “moveable,” the Examiner has asserted that the roll 80 has a groove 82 that receives the blade 76, and that a portion of the web is pushed by notched anvil 74 into the recess. Applicants respectfully disagree.

First, neither the crushing anvil 74 nor the notched anvil 72 *push* the web into any recess. Indeed, as shown in FIG. 6 of Lewyckyj, the notched anvil is spaced above the recess 82 formed behind the blade 76, and the web is never pushed into the

recess. Instead, the blade 76 is angled such that it progressively engages the anvil 72 (Col. 5, lines 50-53; FIGS. 2 and 6; Col. 7, lines 10-13).

Second, the crushing anvil 74,¹ which the Examiner applied as the claimed “insert member,” *never* deflects the blade 76. Rather, Lewyckyj expressly teaches that the unnotched crushing anvil 74 is necessarily spaced a distance “d” from the end of the blade 76 “to prevent cutting of the laminated product 10 as it is carried together with the edge of the resilient blade 76 past the unnotched anvil 74” (Col. 7, lines 19-27; FIG. 6). Accordingly, it is not possible for the anvil 74 to push the web into any recess.

For at least these reasons, Lewyckyj fails to disclose or suggest all of the limitations of claims 5 and 11, and claims 6, 7, 12, 13, 16-19 and 28-30 depending therefrom.

Finally, Applicants note that dependent claim 19 recites that the first and second moveable members “comprise first and second rolls.” Although the Examiner rejected claim 19 as being anticipated by or made obvious over Lewyckyj, the Examiner never explained in the Office Action where or how Lewyckyj disclosed or suggested that anvil 74 (applied as the insert member) can be carried by a roll. Indeed, as explained above, Lewyckyj discloses just the opposite – anvil 74 is necessarily fixed.

Claim 8, 9, 14 and 15:

The Examiner stated that claims 8, 9, 14 and 15 would be allowed if rewritten in independent form. Accordingly, Applicants have rewritten claims 8 and 14 in independent form, with the exception of canceling the recitation of a nip, which was recited in claims 5 and 11 from which they depended respectively. Applicants do not believe the recitation of a “nip” is required for patentability, as evidenced by the Examiner’s omission thereof in his stated reasons for allowance (Office Action at 8).

¹ As opposed to the cutting notched anvil 72.

New Claims:

New claims 28-30 depend from claims 5 and 11 and are allowable for at least the reasons set forth above. None of these new claims has added new matter, and all of the new claims are supported by the specification, including the drawings.

Applicants note that claim 28 recites that the first and second members comprise “first and second rolls respectively.” Accordingly, claim 28 is further patentable for the reasons set forth above with respect to claim 19.

In addition, claims 29 and 30 both recite that the second member or roll has “an outer circumferential surface, wherein said recess is formed radially inwardly from said outer circumferential surface.” Clearly the web of Lewyckyj is never pushed into a recess formed radially inwardly of the outer circumferential surface of roll 80 (See FIG. 6). Accordingly, claims 29 and 30 are further patentable for this additional reason.

Conclusion:

Applicants previously paid for 27 claims, including three (3) independent claims. After this amendment, this application has 22 claims, including five (5) independent claims. Applicants have enclosed a check in the amount of \$172 for the two additional independent claims. Should any additional fees be deemed appropriate, the Commissioner is hereby authorized to charge payment of any fees associated with this communication to Deposit Account No. 23-1925.

If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

Respectfully Submitted,

Dated: May 24, 2004

By:

A handwritten signature in black ink, appearing to read 'A. Stover', is written over a horizontal line.

Andrew D. Stover

Reg. No. 38,629

Attorney for Applicants

BRINKS HOFER GILSON & LIONE LTD.

Post Office Box 10395

Chicago, Illinois 60610

(312) 321-4200